

REMARKS

In the Office Action, the Examiner rejected claims 1-2, 8-12 and 16-18 under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 6,450,674 (Denley) in view of United States Patent No. 6,471,386 (Oh), rejected claims 3-4 and 13 under 35 U.S.C. 103(a) as being unpatentable over a combination of Denley and United States Patent No. 5,927,071 (Asanuma et al.), rejected claims 7 and 15 as being unpatentable over a combination of Oh and United States Patent No. 6,779,835 (Fox et al.), and rejected claims 5-6 and 14 under 35 U.S.C. 103(a) as being unpatentable over a combination of Oh and United States Publication No. 2004/0086324 (Bertram et al.). Applicant respectfully traverses.

Independent claim 1 claims a rotatable input member, gearing in the housing configured to provide that rotation of the rotatable input member causes extension and retraction of said adjuster member, that the adjuster member is extendable and retractable into and out of contact with the expandable member and that the adjuster member is configured to be retractable to such an extent that the end of the adjuster member contacts and pushes on the expandable member. Also claimed is the fact that the expandable member is configured to expand upon the end of the adjuster member contacting and pushing on the expandable member to accommodate retraction of the adjuster member. Claim 11 is similar, but is directed to a method.

In the Office Action, the Examiner rejected claims 1-2, 8-12 and 16-18 under 35 U.S.C. 103(a) as being unpatentable over Oh. According to the Examiner, Denley teaches the claimed invention except for an expandable member. The Examiner asserts that "Oh discloses an expandable member (13), and that the expandable member is configured to expand upon said

Serial No.: 10/689,481
Art Unit: 2875
Page 2

BEST AVAILABLE COPY

second end of said adjuster member contacting and pushing on said expandable member."

Applicant respectfully asserts that the Examiner is misinterpreting Oh. While the Examiner asserts that part number 15 is an adjuster member, part number 15 is merely a snap fitting pin. While Oh does disclose a bellows spring bracket (part number 13), the bellows is not used to accommodate the retraction of an adjuster member upon rotation of a rotatable input member. In Oh, there is no input member which is rotatable to cause the snap fitting pin 15 to retract such that an end of the pin 15 contacts and pushes on part 13. In contrast, the bellows spring bracket is provided merely to withstand impact (see, for example, col. 3, lines 37-40). In Oh, the end of part number 15 is not retractable such that it contacts part number 13, and part number 13 does not expand to accommodate the retraction. Again, Applicant respectfully asserts that the Examiner is misinterpreting the Oh reference.

BEST AVAILABLE COPY

Serial No.: 10/689,481
Art Unit: 2875
Page 3

Furthermore, even if Oh did disclose what the Examiner asserts, Applicant submits that there is no motivation in the prior art to combine Denley and Oh as asserted by the Examiner. As the Federal Circuit stated in In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992):

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. Wilson and Hendrix fail to suggest any motivation for, or desirability of, the changes espoused by the Examiner and endorsed by the Board.

Here the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

In the present case, the prior art did not suggest the desirability of the modification of Denley asserted by the Examiner. Furthermore, there cannot be said to be a suggestion to combine references where the only source of the suggestion comes from the present application. As stated by the Federal Circuit in ACS Hospital Sys., Inc. v. Montefiore Hospital, 732 F.2d 1572, 221 USPQ 929 (1984):

The Court below identified no source, other than the Sonnenberg patent itself, for the suggestion to use override switching means in a television rental system. Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. The prior art of record fails to provide any such suggestion or incentive.

Serial No.: 10/689,481
Art Unit: 2875
Page 4

BEST AVAILABLE COPY

In the present case, the Examiner has not identified any suggestion or incentive to combine the references indicated in the Office Action, other than referring to the present invention itself. As such, Applicant respectfully submits that the combination of Denley and Oh asserted by the Examiner is improper, and the rejection should be withdrawn. Also, as described above, Applicant respectfully submits that Oh does not disclose what the Examiner asserts that Oh discloses. As such, even if Denley and Oh were to be combined, one would not arrive at the present invention.

Applicant respectfully asserts that not only is there no motivation to combine Denley and Oh as the Examiner asserts, but that the Denley reference teaches away from such a modification (i.e., to provide an expandable member which is configured to expand upon an end of the adjuster member contacting and pushing on the expandable member). In Denley (see col. 4, lines 45-50, as well as col. 6, lines 22-37, and col. 12, lines 26-43), member 190c is described as having an internal stop wall 124a which works to limit retraction (as opposed to accommodate retraction as in the present invention) of the adjuster output shaft 104a (viz-a-viz contact between the end 122a of the adjuster output shaft 104a and the internal stop wall 124a of member 190c).

A basic tenet of U.S. patent law is that "an invention that otherwise might be viewed as an obvious modification of the prior art will not be deemed obvious in a patent law sense when one or more prior art references "teach away" from the invention." *Chisum on Patents*, § 5.03[3], at 5-135 (2000). See, for example, Gillette Co. v. S.C. Johnson & Sons, Inc., 16 USPQ2d 1923, 1927 (Fed. Cir. 1990) (stating that the closest prior art reference "would likely discourage the art worker from attempting the substitution suggested by the

Serial No.: 10/689,481
Art Unit: 2875
Page 5

BEST AVAILABLE COPY

[inventor/patentee]"); American Standard Inc. v. Pfizer Inc., 14 USPQ2d 1673, 1707 (D. Del. 1989) (stating that "[a]lthough each reference used in an obviousness inquiry does not have to be enabling . . . disclosures in the references that 'teach away' from the claimed invention cannot be disregarded"); Phillips Petroleum Co. v. U.S. Steel Corp., 6 USPQ2d 1065, 1093 (D. Del. 1987), *aff'd*, 9 USPQ2d 1461 (Fed. Cir. 1989) (holding that "the prior art references relied upon must be considered in their entirety . . . Disclosures in the references that diverge from and teach away from the invention cannot be disregarded"); Dow Chemical Co. v. United States, 18 USPQ2d 1657, 1662 (Cl. Ct. 1990) (stating "this is a classic case of 'teaching away' from the invention").

In light of the foregoing, Applicant respectfully asserts that the rejection of claims 2, 8-12 and 16-18 under 35 U.S.C. 103(a) as being unpatentable over a combination of Denley and Oh should be withdrawn.

In the Office Action, the Examiner also rejected claims 3-4 and 13 under 35 U.S.C. 103(a) as being unpatentable over a combination of Denley and Asanuma et al. In making the rejection, the Examiner discusses Oh and Asanuma et al. Therefore, it is unclear whether the Examiner meant to reject claims 3-4 and 13 under 35 U.S.C. 103(a) as being unpatentable over a combination of Denley, Oh and Asanuma et al., or a combination of only Oh and Asanuma et al. Regardless, Applicant respectfully traverses. As discussed above, Denley does not teach any expandable member and instead discloses member 190c as having an internal stop wall 124a which works to limit retraction (as opposed to accommodate retraction as in the present invention) of the adjuster output shaft 104a (viz-a-viz contact between the end 122a of the adjuster output shaft 104a and the internal stop wall 124a of member 190c). As such, Applicant

Serial No.: 10/689,481
Art Unit: 2875
Page 6

BEST AVAILABLE COPY

respectfully asserts that Denley teaches away from a modification which includes an expandable member that is contacted by an adjuster output shaft during its retraction, whether the expandable member is made out of rubber or not (as set forth in claims 3-4 and 13). Additionally, as described above, Applicant respectfully asserts that the Examiner is misinterpreting Oh. While the Examiner asserts that part number 15 is an adjuster member, part number 15 is merely a snap fitting pin. While Oh does disclose a bellows spring bracket (part number 13), the bellows is not used to accommodate the retraction of an adjuster member upon rotation of a rotatable input member. In Oh, there is no input member which is rotatable to cause the snap fitting pin 15 to retract such that an end of the pin 15 contacts and pushes on part 13. In contrast, the bellows spring bracket is provided merely to withstand impact (see, for example, col. 3, lines 37-40). In Oh, the end of part number 15 is not retractable such that it contacts part number 13, and part number 13 does not expand to accommodate the retraction. Applicant respectfully asserts that the rejection of claims 3-4 and 13 should be withdrawn.

In the Office Action, the Examiner also rejected claims 7 and 15 under 35 U.S.C. 103(a) as being unpatentable over a combination of Oh and United States Patent No. 6,779,835 (Fox et al.), and rejected claims 5-6 and 14 under 35 U.S.C. 103(a) as being unpatentable over a combination of Oh and United States Patent Application Publication No. 2004/0086324 (Bartram et al.). As described above, Applicant respectfully asserts that the Examiner is misinterpreting Oh, and that Oh does not disclose an expandable member that is configured to expand upon an end of an adjuster member contacting and pushing on the expandable member. Additionally, in Oh, there is no input member which is rotatable to cause the snap fitting pin 15 to retract such

Serial No.: 10/689,481
Art Unit: 2875
Page 7

BEST AVAILABLE COPY

that an end of the pin 15 contacts and pushes on part 13. In contrast, the bellows spring bracket is provided merely to withstand impact (see, for example, col. 3, lines 37-40). In Oh, the end of part number 15 is not retractable such that it contacts part number 13, and part number 13 does not expand to accommodate the retraction. Applicant respectfully asserts that the rejection of claims 7 and 15 citing a combination of Oh and Fox et al. should be withdrawn, and that the rejection of claims 5-6 and 14 citing a combination of Oh and Bertram et al. should be withdrawn.

Independent claim 1 claims a rotatable input member, gearing in the housing configured to provide that rotation of the rotatable input member causes extension and retraction of said adjuster member, that the adjuster member is extendable and retractable into and out of contact with the expandable member and that the adjuster member is configured to be retractable to such an extent that the end of the adjuster member contacts and pushes on the expandable member. Also claimed is the fact that the expandable member is configured to expand upon the end of the adjuster member contacting and pushing on the expandable member to accommodate retraction of the adjuster member. Claim 11 is similar, but is directed to a method. Applicant respectfully submits that none of the cited references, either alone or in combination, disclose or suggest the present invention as claimed.

Serial No.: 10/689,481
Art Unit: 2875
Page 8

BEST AVAILABLE COPY

Applicant respectfully asserts that claims 1 and 11 of the present application, and those claims which depend therefrom, are allowable, and that the present application should be passed to issuance.

Should the present claims not be deemed adequate to effectively define the patentable subject matter, the Examiner is respectfully urged to call the undersigned attorney of record to discuss the claims in an effort to reach an agreement toward allowance of the present application.

Respectfully submitted,

Date: March 16, 2006

By: 

Richard A. Giangiori, Reg. No. 24,284

James R. Foley, Reg. No. 39,979

Attorneys for Applicant

TREXLER, BUSHNEIL, GIANGIORGI,

BLACKSTONE & MARR, LTD.

105 West Adams Street, 36th Floor

Chicago, Illinois 60603-6299

Tel: (312) 704-1890

942485 WPD

BEST AVAILABLE COPY

Serial No.: 10/689,481

Art Unit: 2875

Page 9